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09/234,253	01/20/1999	RAYMOND SELTZER	A-21835/P2/C	6356
324	7590	10/01/2004	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			ALVO, MARC S	
PATENT DEPARTMENT			ART UNIT	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/234,253
Filing Date: January 20, 1999
Appellant(s): SELTZER ET AL.

Tyler A. Stevenson
For Appellant

MAILED

OCT 01 2004

EXAMINER'S ANSWER

GROUP 1700

This is in response to the appeal brief filed July 6, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of claims.*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments After Final.*

Art Unit: 1731

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) ***Summary of invention.***

The summary of invention contained in the brief is correct, except claim 45 is not under consideration.

(6) ***Issues.***

The appellant's statement of the issues in the brief is correct.

(7) ***Grouping of claims.***

The rejection of claims 1-11, 35-40 and 44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Appellant states that these claims are argued as a group for the one issue and therefore stand or fall together.

(8) ***Claims appealed.***

The copy of the appealed claims contained in the Appendix to the brief is correct. Claim 45 is allowed and not subject to the Appeal.

(9) ***Prior Art of record.***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal

REFERENCES

U.S Patents

5,051,511	SELTZER ET al	9-1991
5,459,222	RODGERS et al	03-1999

(10) *New prior art.*

No new prior art has been applied in this examiner's answer.

(11) *Grounds of rejection.*

The following grounds of rejection are applicable to the appealed claims.

Claims 1-11, 35-40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELTZER et al in view of RODGERS et al.

SELTZER et al teaches adding mixtures of UV absorbers and light stabilizing agents, including N,N-diethylhydroxylamine (column 11, line 35 and column 12, line 66), to polymer coating compositions including polyurethane (column 8, line 12) and polyesters (column 8, line 30). RODGERS et al teaches polyurethane and polyester coating compositions containing UV absorbers, including benzotriazoles (column 5, line 28 and Example 1), can be used to coat paper and textiles to prevent fading of dyes (column 1, lines 35-40 and abstract). It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes, e.g. reducing the loss of brightness, in the manner taught by RODGERS et al. SELTZER et al teaches that benzotriazoles are of particular value as the UV absorber. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. The claimed N,N-diethylhydroxylammonium citrate would be a salt of and an obvious variant of the genus N,N-hydroxylamine. It would have been obvious to combine the teachings of SELTZER with that of

Art Unit: 1731

RODGERS to obtain the benefits of both preventing fading and increasing brightness. Besides, the claims drawn to a composition and not to the use of the composition. As set forth above, It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes in the manner taught by RODGERS et al.

(12) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(13) *Response to argument.*

The arguments that polyurethane and polyester coatings are unknown as paper coatings, including the Declaration of Mr. David Vidal, are not convincing as RODGERS et al teaches that the composition can be used to coat paper. RODGERS et al teaches, column 8, lines 35-38, "for paper, addition to wet pulp, but here also, surface application by a spraying or a coating process is preferable. It is possible to mix the inventive UV-absorbing polymers with other finishing agents for paper". SELTZER teaches using both light absorbers and light stabilizing agents. It would have been obvious to use the UV absorber of RODGERS for the UV absorber of SELTZER. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. It would have been prima facie obvious to substitute one known UV-absorber for another. Both SELTZER et al and RODGERS et al solve the problem of the degradation effect of

Art Unit: 1731

light on paper coatings. Obviously when the coatings are used on paper as taught by RODGERS et al, the coatings of SELTZER et al would further prevent the loss of brightness (SELTZER et al, column 13, line 49-50) and enhance resistance to yellowing (column 13, lines 29-32) to the coated paper. Besides, the claims of the instant case are drawn to a composition. The use of the composition, e.g. to enhance resistance to yellowing, can not be given probative weight in a product claim.

It is noted that the instant Application also discloses that the method can apply the additive at the coater or sprayer (instant specification, page 11, lines 14 and 15) and that "the stabilizer and/or co-additives may be formulated into a paper sizing or coating composition" (instant specification, page 11, places (h) and (k) and page 11, last paragraph, last sentence). Thus the instant process for preventing the loss of brightness and for enhancing resistance to yellowing of pulp or paper can be by applying a coating. This is substantially the same way that SELTZER et al and/or RODGERS et al prevent degradation due to the effect of light. Thus the problem solved by Applicant would have been obvious from the combined teachings of SELTZER et al and RODGERS et al. The problem of enhancing the resistance to yellowing is a problem of the coating and not of the substance to which it is applied.

Claim 11 is drawn to the elected species, which on page 14 of the instant specification is disclosed as being "CIBAFast®W". This is the same benzotriazole used in Example 21 of RODGERS et al. Although Applicant argues that the "CIBAFast®W" of Example 21 is an ineffective stabilizer, it actually is a better UV absorber than the other benzotriazole UV absorber (LS008). It would have been prima facie obvious to substitute the better UV absorber benzotriazole ("CIBAFast®W") for the other benzotriazole of SELTZER et al. Besides non-

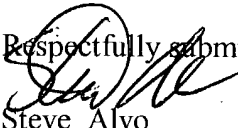
Art Unit: 1731

preferred embodiments or disclosures as being unsatisfactory for intended use can be the foundations for holdings of obviousness, In re Boe, 148 USPQ 507; In re Lamberti, 192 USPQ 278; In re Burckel, 201 USPQ 70.

The argument that SELTER et al teaches using many different coating compositions is not convincing as SELTZER et al is using (Example 21) polyurethane and "CIBAFast®W". This is the same type of compound used by Appellant. It would have been obvious from the teachings of ROGERS et al to use "CIBAFast®W" with the polyurethane coating disclosed by SELTZER et al to prevent yellowing and prevent light degradation.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Steve Alvo
Primary Examiner
Art Unit 1731

msa

September 26, 2004

Conferees

Patrick Ryan

Steve Griffin 